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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/782,968

02/20/2004

Kevin J. Williams

W1107/20009

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03/04/2011

CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD.

Attn: PTO Customer No. 31717

11TH FLOOR, SEVEN PENN CENTER

PHILADELPHIA, PA 19103-2212

EXAMINER

HARRIS, ALANA M

ART UNIT

PAPER NUMBER

1643

NOTIFICATION DATE

DELIVERY MODE

03/04/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@crbcp.com

| | | | |
|------------------------------|---|---|--|
| Office Action Summary | Application No. 10/782,968 | Applicant(s) WILLIAMS, KEVIN J. | |
| | Examiner Alana M. Harris, Ph.D. | Art Unit 1643 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 241, 244, 245, 248, 249, 252, 253, 256, 265-276, 278-289, 291-297, 299-303, 305-317, 319-329, 331-348, 350-355, 357-359 and 361-370 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 241,244,245,248,249,252,253,256,265-276,278-289,291-297,299-303,305-317,319-329,331-348,350-355,357-359 and 361-370.

DETAILED ACTION

Response to Arguments and Amendments

1. Claims 241, 244, 245, 248, 249, 252, 253, 256, 265-276, 278-289, 291-297, 299-303, 305-317, 319-329, 331-336, 338-348, 350-355, 357-359 and 361-370 are pending.

Claims 272, 309 and 319 have been amended.

Claims 241, 244, 245, 248, 249, 252, 253, 256, 265-276, 278-289, 291-297, 299-303, 305-317, 319-329, 331-336, 338-348, 350-355, 357-359 and 361-370 are examined on the merits.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Withdrawn Grounds of Objection

Claim Objections

3. The objection of claim 309 is no longer because Applicant has deleted the repetitive term, the in step 7 within the claim.

Withdrawn Rejections

Claim Rejections – 35 USC § 102

4. The rejection of claims 241, 244, 245, 248, 249, 252, 253, 256 and 256-276, 278, 279, 280-289, 291-297, 299-303 and 305-316 under 35

U.S.C. 102(e) as being anticipated by McCarthy/ U.S. Patent Application

Publication number 2003/0166017 A1 (filed November 9, 2001) is withdrawn.

The Examiner acknowledges Applicant's Remarks submitted November 18, 2010 in regard to this formerly pending rejection on page 24. The Examiner erred in her statement made on page 4, paragraph 7 of Action mailed July 9, 2010. The Examiner apologizes for any confusion this response caused.

Maintained Grounds of Rejection

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

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F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. The rejection of claims 241, 244, 245, 248, 249, 252, 253, 256, 265-276, 278-289, 291-297, 299-303, 305-317, 319-329, 331-336, 338-348, 350-355, 357-359 and 361-370 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,655,411 B2 (issued February 2, 2010) is maintained. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim set of both documents share the active method step of

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measuring an individual's plasma level of thrombospondin fragment or fragments with a binding agent, wherein the fragment sizes are the same in order to detect the presence and/or clinical course of a neoplastic disease.

Applicant has submitted a Terminal Disclaimer (TD) that has not been approved because the person who signed the TD does not have power of attorney. An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c). Applicant must resubmit the TD with the proper documentation.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (571)272-0831. The Examiner works a *flexible schedule*, however she can normally be reached between the hours of 8 am to 8 pm, Monday through Friday.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Misook Yu, Ph.D. can be reached on (571) 272-0839. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alana M. Harris, Ph.D.
28 February 2011

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/Alana M. Harris, Ph.D./
Primary Examiner, Art Unit 1643